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<i>Inventor:</i>	Gary W. Sinde	}
		}
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<i>Examiner:</i>	Donald L. Champagne	}

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**REPLY BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This reply brief is submitted in response to the Examiner's answer dated May 28, 2008. In section (10) of the answer, the Examiner notes the requirements from In re Clay, 966 F.2d 656, 23 USPQ2d 1058, for prior art to be analogous. The Examiner then proceeds to ignore the requirements by making the following leap of logic:

"The matter to which appellant's endeavor deals is: identifying the source of a signal by comparing its spectrum to the spectra of known sources. *In its simplest form (independent claim 1 and 21), that's it. Again, in its simplest form, Nickolls does exactly the same thing (para. 6 and 8 of the rejection).* Furthermore, the examiner has made of record a declaration

(reproduced above and discussed below) attesting that he and other members of a General Electric Company team *practiced this same basic invention more than 30 years ago*. Nickolls is analogous and the subject 103(a) rejection is valid because Nickolls is very pertinent to the particular problem with which the instant inventor is concerned.” (The answer, page 8, line 27-page 9, line 5, emphasis Appellant’s);

and later

“As noted above, *it does not matter whether the unknown signal is of internal or external origin*. The source of the unknown signal can be identified in either case by comparing its spectrum to the spectra of known sources. That is what Nickolls teaches. That is what the Champagne declaration teaches. *And that, quite simply, is what the instant invention claims.*” (The answer, page 11, lines 18-22, emphasis Appellant’s);

and still later

“In all three cases [Appellant’s claims, Nickolls and the Champagne declaration], an unknown source is identified by comparing its spectrum to the spectra of known sources. One of ordinary skill in the diagnostic art would readily understand that teaching from Nickolls and apply it to the identification of “a source of ingress”, as the instant invention claims.” (The answer, page 11, lines 27-31).

This argument is the old “gist of the invention” test for patentability roundly rejected in case law since the effective date of the Patent Act of 1952.

We find the district court’s concern with “what the invention is” misplaced, and its requirement that the ‘081 drawings “describe what is novel or important” legal error. There is “no legally recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention in a combination patent.” Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U.S. 336, 345, 81 S.Ct. 599, 604, 5 L.Ed.2d 592 (1961). “The invention” is defined by the claims on appeal. The instant claims do not recite only a pair of semi-circular lumens, or a conical tip, or a ratio at which the tip tapers, or the shape, size, and placement of the inlets and outlets; they claim a double lumen catheter having a combination of those features. That combination invention is what the ‘081 drawings show. As the district court itself recognized, “what Mahurkar eventually patented is exactly what the pictures in serial ‘081 show.” Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1565, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991).

The court must consider all elements of the claimed invention and cannot compare the prior art with what one may consider as the gist of the invention (citing Perkin-Elmer Corp. v.

Computervision Corp., 732 F.2d 888, 894 (Fed.Cir.), cert. denied, 469 U.S. 857, 105 S.Ct. 187, 83 L.Ed.2d 120 (1984); W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 1548 (Fed.Cir.1983), cert. denied, 469 U.S. 851, 105 S.Ct. 172, 83 L.Ed.2d 107 (1984)). ITT Corp. v. U.S., 10 Cl. Ct. 321, 335 (Cl. Ct. 1986).

The Examiner concedes that the reference is not in the same field as the claimed invention. However, the Examiner takes the position that Nickolls is pertinent to the problem with which the claimed invention is concerned. The Examiner argues that the claimed invention identifies the source of a signal by comparing its spectrum to the spectra of known sources, and that that is exactly what Nickolls does. As noted in Vas-Cath and ITT Corp., *supra.*, the Examiner cannot employ a “gist of the invention” analysis to determine patentability. The Examiner must find each element of the claim in the art in 35 U. S. C. §103 obvious combination with every other element of the claim. The Examiner cannot decide “what is novel or important” or identify some “legally recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention.” And, the Examiner cannot ignore words in the claim in making his case of 35 U. S. C. §103 obviousness. See, for example, ITT, *supra.*, at 336 (“[W]here the preamble ‘[points] out the invention defined by the claim’ or gives ‘life, meaning and vitality to the claims,’ then the preamble will constitute a limitation,” citing Kropa v. Robie, 187 F.2d. 150 (C.C.P.A. 1951)).

Footnote 3 in the Examiner’s answer is in error. See section (8) of the current rejection, lines 1-2. Section (8) of the current rejection is reproduced in the Examiner’s answer for the Board’s convenience.

The Examiner argues that the disclosed purpose of Appellant’s invention is “identification of sources of ingress noise” in cable TV systems. The Examiner argues that it does not matter what the disclosed purpose of Appellant’s invention is, that what matters is that both Nickolls and Appellant’s invention identify the source of a signal by comparing its spectrum to the spectra of known sources. The Examiner is wrong. *What matters is what the claims recite.* What the claims say must always be the focus of the Examiner’s inquiry.

Independent claims 1, 23, 33, 43, 70, 81, and 92 all recite at least one sleeve nut threaded onto a stud shaft. The Examiner took the position that “[s]leeve nuts come in many different shapes and sizes” and thus the term “sleeve nut” as claimed does not define anything structurally different from the nut in Schwartz [ ]. The Appellant argues that the Examiner’s interpretation of “sleeve nut” is overly broad because it ignores the word “sleeve” entirely [ ]. We agree with the Appellant.

It is clear to us that a sleeve nut, as that term is used in the art [

], means something more than just a plain hex nut. The word “sleeve” implies that the sleeve nut includes a sleeve portion in addition to a head or nut end portion, as described in Borst [ ]. The Examiner’s interpretation of “sleeve nut” as being broad enough to include simply a nut is unreasonable in view of the words “sleeve nut” used in the claims. Our understanding of the scope of the recited “sleeve nut” is also consistent with the Appellant’s own description of the tubular sleeve nut 41 in the Specification as having a tubular segment 51 and a head 57 [ ]. As such, the Schwartz threaded nut 88 is not a sleeve nut as claimed because it does not include a sleeve portion [ ]. For this reason, we cannot sustain this rejection [ ]. Ex parte Pazdirek, 2007 WL 2745845, \*5 (Bd. Pat. App. & Interf., 2007)

The Examiner argues that the 103(a) rejection is valid because Nickolls is very pertinent to the particular problem with which the Appellant’s invention is concerned. The Board need only read the quote from In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), contained in the appeal brief to understand the difficulty inherent in the Examiner’s view. The Examiner argues that he provided the Champagne declaration to illustrate this point, but the Champagne declaration does not, can not, make Nickolls analogous. Nickolls is or is not analogous on Nickolls’s own merit, and does not become analogous because of anything contained in the Champagne declaration. Appellant’s view is that Nickolls, by the tests applied in Clay, In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and other non-analogous art decisions, is non-analogous.

The Examiner argues that “[t]he instant and reference inventions deal with the science of diagnostic analysis.” Appellant’s undersigned counsel sought some reference to this science, and found diagnostic analysis used in a wide range of fields including human fertility, stock market behavior, a study of the Lake Victoria basin and retail stocking patterns. See, for example, <http://www.google.com/search?hl=en&rls=SUNA,SUNA:2008-10,SUNA:en&q=diagnostic+analysis&start=20&sa=N>. Appellant submits that there is no doubt about the non-analogous nature of these fields, so identifying Nickolls and Appellant’s invention with “the science of diagnostic analysis” may be the best evidence of all to support the non-analogous nature of Nickolls to Appellant’s claims.

The Examiner argued that “engineers tend to learn this discipline [the science of diagnostic analysis] through practice, and well understand its basic principles when they achieve the 10-20 years of experience that characterize one of ordinary skill in most

engineering arts.” The answer, page 10, lines 7-9. However, the Examiner has not, by the Champagne declaration or by any other evidence in the record of this application, established himself as expert in (1) what engineers in general learn, (2) how long it takes engineers in general to learn it, or (3) what characterizes someone as “one of ordinary skill in most [indeed any] engineering art[ ].” The same observation is true for the Examiner’s statement (the answer, page 10, lines 15-16) that “[he] was typical [during the period described in the Champagne declaration (1973-76)] of GE staff of similar age and not very different from [his] peers in most engineering disciplines and industries.” The Examiner cannot possibly know this. Just as an example of the purely speculative nature of this statement, how many “GE staff of similar age and [ ] peers in most engineering disciplines and industries” now are Ph.D.s? Appellant submits, not so many. As another, how many of “[his] peers in most engineering disciplines and industries” does the Board suppose the Examiner knew in 1973-76 that qualifies him to conclude that he was “not very different” from “[his] peers in most engineering disciplines and industries?” Appellant submits, not so many.

The Examiner next notes that “We [four GE engineers who constituted the answer’s original “Transition Piece Task Force”] learned as others do, from the published prior art, while receiving some guidance from our GE colleagues in the aircraft gas turbine business.” The answer, page 10, lines 18-20. Again, the Examiner has not presented any fact which would qualify him to know or opine on how someone else learned anything. He could explain how he learned something. That is all. The Examiner next notes that “We used off-the-shelf diagnostic equipment.” The answer, page 10, lines 20-21. Of course, patentable inventions flow every day from laboratories where off-the-shelf equipment is used. That statement by the Examiner establishes no fact of any consequence here.

The Examiner observes that “a completed packaged power plant of the kind described in the declaration, under normal operation, is quite quiet to a human observer standing near the machine.” The answer, page 11, lines 3-5. A couple of points here. First, the word “packaged” is critical to this statement. The packaging in question includes considerable sound deadening material, which is what makes it possible for “a human observer [to] stand[ ] near the machine.” Second, and as noted in the appeal brief, the noise that destroyed the Champagne declaration’s turbine was noise generated within the turbine, not noise from outside the turbine. The Examiner himself notes that the noise level inside the turbine was 186 dBa. That’s loud. Appellant stands by his appeal brief observation that “assuming there is any noise ingress into a working gas turbine [ ], such noise is completely swamped to the point of being undetectable over the noise generated by the gas turbine

itself.”

The Examiner states (the answer, page 11, lines 8-9) that all of the Champagne declaration activities took place in or before 1976. That, without more, does not put the activities described in the Champagne declaration in any of the categories of 35 U. S. C. § 102. That, without more, does not make the activities described in the Champagne declaration prior art. The Examiner states (the answer, page 11, line 10) that the GE task force described in the Champagne declaration used off-the-shelf diagnostic equipment. That, without more, does not put the activities described in the Champagne declaration in any of the categories of 35 U. S. C. § 102. That, without more, does not make the activities described in the Champagne declaration prior art. The Examiner states (the answer, page 11, lines 10-11) that the GE task force described in Champagne declaration relied on publicly-known art. That, without more, does not put the activities described in the Champagne declaration in any of the categories of 35 U. S. C. § 102. That, without more, does not make the activities described in the Champagne declaration prior art. The Examiner states (the answer, page 11, line 11) that “Nothing attested to [in the answer] or in the [Champagne] declaration was a GE trade secret.” The Examiner purports to be speaking on behalf of General Electric, but the Examiner certainly has not stated facts sufficient for the Board to conclude that he is qualified to speak on behalf of General Electric. The Examiner alleges (the answer, page 11, lines 12-13) that the GE task force activities described in the Champagne declaration establish a *prima facie* case of public use, but the Examiner has not stated facts sufficient for the Board to conclude that the activities described in the Champagne declaration even constituted a public use, let alone rose to the level of establishing a *prima facie* case of public use.

All remaining issues have been dealt with in the appeal brief.

The rejections of Appellant’s claims are erroneous and should be reversed.  
Such action is respectfully requested.

Respectfully submitted,



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